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10/830,115	04/23/2004	Loren Eckart	59683.000002	9016

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EXAMINER	
COLON, CATHERINE M	
ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/830,115	Applicant(s) ECKART ET AL.	
	Examiner C. Michelle Colon	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-99 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>June 9, 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a Non-Final Office Action in response to the communication received on April 23, 2004. Claims 1-99 are now pending in this application.

Information Disclosure Statement

2. The examiner has reviewed the patents supplied in the Information Disclosure Statement (IDS) received on June 9, 2005.

Claim Objections

3. Claim 2 is objected to because of the following informalities: Claim 2 is recited as depending on claim 2. The claim will be interpreted as depending on claim 1.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-23 and 74-89 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As per the first prong of the test, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences) and therefore are found to be non-statutory subject matter. For a process claim to be satisfactory, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, method claims 1-23 and 74-89 merely recite the steps for receiving performance data in the form of responses to a survey; however, the recited steps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in person or by use of a pencil and paper and without the need of a computer or other technology. The few method claims that recite use of technology, recite a nominal and trivial use of technology as the technology is merely used to gather and/or display data. In other words, the use of technology must convert/manipulate data in a meaningful and non-trivial way.

As per the second prong of the test, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces survey response data (i.e., concrete) and uses the data to analyze and make changes to business practices (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-23 and 74-89 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 2, 7-15, 21, 23-27, 30, 32-46, 52, 54-58, 61, 63-82, 84-97 and 99 are rejected under 35 U.S.C. 102(a,e) as being anticipated by D'Alessandro (U.S. 6,556,974).

As per claim 1, D'Alessandro discloses a method for automated management of performance information associated with at least one business, the method comprising:

obtaining performance information associated with a business, the performance information having a first format based on a first set of performance classifications (col. 5, lines 44-50; col. 9, lines 7-18; Figure 3; The system obtains performance information associated with a business by administering surveys to employees and/or non-employees, the surveys requesting information about various performance criteria of the business. Answers to the surveys are received in a first format (i.e., yes/no and quantified percentage) specified by the survey administrator, the answers representing specific performance criteria/classifications.);

converting, using an automated process, the performance information from the first format to a second format based at least in part on a mapping of one or more performance classifications of the first set of performance classifications to one or more respective performance classifications of a second set of standardized performance classifications (col. 9, lines 41-53; Using mathematical formulas and Likert averages, results from the surveys are converted to a second format called Organizational Success Ratios (OSRs), which represents the business' performance strengths and weaknesses, a broader performance classification.); and

analyzing the converted performance information based at least in part on one or more performance metrics (col. 8, lines 39-51; col. 9, line 65-col. 10, line 7; Figure 5; The performance information is analyzed in terms of several performance metrics.).

As per claim 2, D'Alessandro discloses the method as in Claim 1, further comprising: generating one or more performance reports based on the analysis of the converted performance information (col. 8, lines 39-51; Figure 5; The system generates a scorecard report based on the analysis of the converted performance data.).

As per claim 7, D'Alessandro discloses the method as in Claim 1, further comprising the steps of:

obtaining performance information associated with a second business, the performance information having a third format based on a third set of performance classifications (col. 7, lines 57-59; The scorecards can include performance data of other businesses.);

converting, using an automated process, the performance information associated with the second business from the third format to the second format based at least in part on a mapping of one or more performance classifications of the third set of performance classifications to one or more respective performance classifications of the second set of performance classifications (col. 9, line 54-col. 10, line 7; The system can covert the OSR data (i.e., the second format) into a Baldrige equivalency formula (i.e., a third format). This converts the ratios into percentages for each performance metric.); and

analyzing the converted performance information associated with the second business based at least in part on one or more performance metrics (col. 9, line 58-col. 10, line 7; Figure 5; The performance information is analyzed and compared to the performance metrics of other organizations.).

As per claim 8, D'Alessandro discloses the method as in Claim 7, further comprising:

generating one or more performance reports based on results of the analysis of the converted performance information associated with the second business (col. 7, lines 57-59; col. 9, line 65-col. 10, line 7; Figure 5; The scorecard represents a performance report of the business. The scorecard can contain performance scores of other businesses.).

As per claim 9, D'Alessandro discloses the method as in Claim 7, further comprising:

aggregating the converted performance information associated with the first and second businesses and analyzing a performance of at least one of the first and second businesses based on one or more representative performance metrics from the aggregated converted performance information (col. 7, lines 57-59; col. 9, line 65-col. 10, line 7; Figure 5; The performance information is aggregated to indicate and overall performance level for each metric (using percentages). The scorecard can contain performance scores of other businesses.).

As per claim 10, D'Alessandro discloses the method ms in Claim 1, wherein obtaining the performance information includes receiving the performance information as one or more data files uploaded via a website (col. 3, lines 14-17 and 36-40; Figure 2).

As per claim 11, D'Alessandro discloses the method ms in Claim 1, further comprising providing the one or more performance reports to at least one requesting party (col. 5, line 60-col. 6, line 2; The survey administrator receives and compiles the survey results and communicates it back to personnel within the organization.).

As per claim 12, D'Alessandro discloses the method as in Claim 11, wherein the one or more performance reports are provided via a website (col. 3, lines 36-40; Figure 2).

As per claim 13, D'Alessandro discloses the method as in Claim 1, wherein the conversion of the performance information from the first format to the second format is performed at least in part using one or more software programs (col. 3, lines 12-14; The

system automatically converts the data formats from the survey results, and therefore uses software to collect and analyze the survey data.).

As per claim 14, D'Alessandro discloses the method as in Claim 13, wherein the performance information is converted from the first format to the second format using a conversion map indicating correlations between performance classifications of the first set of performance classifications and performance classifications of the second set of performance classifications (col. 9, lines 41-53; Using mathematical formulas and Likert averages (i.e., conversion mapping), results from the surveys are converted to a second format called Organizational Success Ratios (OSRs), which represents the business' performance strengths and weaknesses, a broader performance classification.).

As per claim 15, D'Alessandro discloses the method as in Claim 1, wherein the business is one of a group consisting of: a private business', a public business', a non-profit organization; and a government agency (col. 4, lines 5-13).

As per claim 21, D'Alessandro discloses the method as in Claim 1, further comprising:

delivering at least a portion of the converted performance information to a requesting party as one or more data files having a format compatible with software operated by the requesting party (col. 3, lines 7-17 and 36-40; col. 5, line 60-col. 6, line 2; Figure 2; The survey administrator receives and compiles the survey results and communicates it back to personnel within the organization.).

As per claim 23, D'Alessandro discloses the method as in Claim 1, wherein the performance information includes operational information and where one or more of the

performance classifications of the first set of performance classifications includes an operational classification and one or more of the performance classifications of the second set includes an operational classification correlated to a operational classification of the first set (col. 8, line 67-col. 9, line 6; The system discloses that a performance metric for the business results classification/category includes the operations area.).

Claims 24-27, 30, 32-46, 52, 54-58, 61, 63-82, 84-97 and 99 recite substantially similar subject matter as claims 1, 2, 7-15, 21 and 23 above. Therefore, claims 24-27, 30, 32-46, 52, 54-58, 61, 63-82, 84-97 and 99 are rejected on the same basis as claims 1, 2, 7-15, 21 and 23 above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-6, 16-20, 22, 28, 29, 31, 47-51, 53, 59, 60, 62, 83 and 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Alessandro (U.S. 6,556,974) as applied above.

As per claims 3, 16 and 20, D'Alessandro discloses the method as in Claims 2 and 1, wherein the one or more performance reports includes showing levels/thresholds

of performance the business falls in for each criteria, by way of percentages, where 1% is very weak and 100% is perfect (col. 9, lines 47-53 and 58-64). D'Alessandro does not expressly disclose at least one alert indicator to identify whether a metric exceeds a threshold. However, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the reports of D'Alessandro to indicate a percentage exceeding a predetermined value or threshold (by adjusting the color or boldness via a text message on the report, for example) as it is old and well known to adjust the display/layout of reports to enhance ease of use and readability for users. Creating an alert indicator (i.e., a text message) on the reports showing that a percentage for a performance metric has exceeded a predetermined value would enhance the ease of use and readability for users of the system of D'Alessandro, which D'Alessandro has shown to be an important factor for its reports through its implementation of user-friendly scorecard reports (Figure 5).

As per claims 4 and 17, D'Alessandro discloses the method as in Claims 3 and 16, wherein the predetermined value includes a value of the performance metric from a previous period (col. 4, lines 2-4 and 29-31; col. 5, lines 60-65; Survey data from previous periods are used for baseline analysis of the performance data.).

As per claims 5 and 18, D'Alessandro discloses the method as in Claims 3 and 16, wherein the predetermined value includes a target value set for the at least one performance metric (col. 9, lines 47-53 and 58-64; The performance reports include showing levels/thresholds of performance the business falls in for each criteria, by way of percentages, where 1% is very weak and 100% is perfect.).

As per claims 6 and 19, D'Alessandro discloses the method as in Claims 3 and 16, wherein the predetermined value includes a value representative of performance values for other businesses (col. 7, lines 57-59; The score card can compare a business' scores to those of other businesses.). However, D'Alessandro does not expressly disclose the predetermined value being an industry average for the at least one performance metric. However, if the system of D'Alessandro maintains the performance metric scores of other businesses, then the system of D'Alessandro would easily be able to compute the industry average by adding all of the businesses' scores and then dividing by the total number of businesses. Additionally, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of D'Alessandro to compare a business' performance metric scores with that of an industry average so the business can assess its level of performance (i.e., above or below its competitors) to determine any necessary business process changes, which is a goal of the scorecard (col. 8, lines 43-51).

As per claim 22, D'Alessandro discloses the method as in Claim 1, wherein the performance information includes financial information (col. 8, line 67-col. 9, line 6; The system discloses that a performance metric for the business results classification includes the financial area.). D'Alessandro does not expressly disclose where one or more of the performance classifications of the first set of performance classifications includes a financial account and one or more of the performance classifications of the second set includes a financial account correlated to a financial account of the first set. However, it would be difficult for the system of D'Alessandro to analyze performance

metrics related to financial information without having at least one financial account to associate a specific performance metric with. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art for the system of D'Alessandro to correlate a financial information performance metric to a financial account because doing so would provide D'Alessandro with specific financial data with which to assess financial performance and furthermore, if a business has more than one financial account, this would allow the system of D'Alessandro to further narrow the financial performance metrics down to an individual accounts level, thus enhancing the data provided in the scorecard.

Claims 28, 29, 31, 47-51, 53, 59, 60, 62, 83 and 98 recite substantially similar subject matter to claims 3-6, 16-20 and 22 above. Therefore, claims 28, 29, 31, 47-51, 53, 59, 60, 62, 83 and 98 are rejected on the same basis as claims 3-6, 16-20 and 22 above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Powers et al. (U.S. 5,684,964) discusses a method and system for monitoring organizational performance;
- Powers et al. (U.S. 6,615,182) discusses a system and method for defining organizational structure for evaluating organizational performance;

- Powers et al. (U.S. 5,500,795) discusses a system and method for controlling the performance of a call center; and
- Fitzgerald (U.S. 6,434,533) discusses a method for reporting performance data in business relating to inventory.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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C. Michelle Colón
Patent Examiner
Art Unit 3623

August 22, 2005